

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

REMARKS

Claims 20-26, 28 and 95-102 were pending in the application prior to this amendment. Claim 20 has been amended herein. Claims 28 and 95-102 have been canceled. Claims 21-26 remain in the application unchanged by this amendment. New claims 103 and 104 have been added. Accordingly, after entry of this amendment, claims 20-26, 103 and 104 will be pending in the application. Reexamination and reconsideration are requested.

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

I. Brief History of this Prosecution

On February 21, 2003, the Examiner issued a restriction requirement. Applicant responded to the restriction requirement on April 15, 2003, by electing claims 20-28 for further prosecution.

On May 28, 2003, a first Office action on the merits was mailed. In this action, the Examiner rejected claims 20-28 and withdrew from consideration non-elected claims 29-94.

On August 19, 2003, applicant filed a response to the action mailed May 28, 2003. In this response, applicant presented several arguments countering the Examiner's rejections of claims 20-28. A minor amendment to dependent claim 21 was also presented.

On September 23, 2003, an Office action was mailed in which the Examiner withdrew all of the previous rejections of claims 20-28 but imposed a new double patenting rejection of independent claim 20. The Examiner indicated that dependent claims 21-28 would be allowable if rewritten in independent form.

On December 23, 2003, applicant filed a response to the Office action mailed September 23, 2003. In an effort to secure early allowance of the application, applicant amended the application to include some of the claims indicated as being allowable by the Examiner. Specifically, applicant amended independent claim 20 to include the limitations of dependent claim 27. Applicant added new independent claim 95 which was a combination of the subject matter of independent claim 20 and dependent claim 21. Applicant also added new dependent claims 96-102 which corresponded to dependent

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

claims 22-28, respectively.

On January 30, 2004, an Office action was mailed in which the Examiner applied a new ground of rejection to finally reject all of the claims in the application.

On February 3, 2004, applicant filed a Request for Withdrawal of Finality, requesting that the finality of the rejection mailed January 30, 2004, be withdrawn.

On February 12, 2004, the Examiner issued an action granting applicant's request to withdraw the finality of the January 30, 2004, action. In the February 12 action, the Examiner also indicated that applicant's "reply" filed February 3, 2004, was not responsive to the prior Office action and required that applicant fully respond within 30 days.

The current response is intended to be responsive to both the final Office action mailed January 30, 2004, and the Office action mailed February 12, 2004. In view of the Examiner's change in position with respect to the allowability of the subject matter in the dependent claims, applicant amends the application herein to reinstate the claimed subject matter as it appeared prior to applicant's last response. Specifically, independent claim 20 has been amended to remove the dependent claim 27 limitations previously added. Newly added claims 103 and 104 correspond to prior dependent claims 27 and 28, respectively. Claims 21-26 depend from independent claim 20 and have not been amended herein. All of the remaining claims have been canceled. Accordingly, after entry of the amendment presented in this response, claims 20-26, 103 and 104 will be pending. These claims correspond to claims 20-28, respectively, as these claims appeared prior to

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

applicant's last response. Claim 20, as amended herein, is identical to claim 11 in United States Patent No. 6,145,736, which is of record in the prosecution history of the parent application (i.e., U.S. Patent Application Serial No. 09/220,065).

For the record, applicant respectfully asserts that the Examiner's requirement in the Office action of February 12, 2004, that applicant fully respond to the prior action within 30 days is improper. Applicant's request filed February 3, 2004, was not intended to be a response to the final Office action but only a request to withdraw the finality of the final Office action. In any event, this is seen to be a moot point since applicant is, in fact, filing the current response within the 30 day period set by the Examiner.

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

II. Legal Basis for Prior Art Claim Rejections Made in the Office Action

Legal Basis for Claim Rejection Under 35 U.S.C. §102

The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. 102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ 81, 90 (Fed. Cir. 1986).

Legal Basis for Obviousness under 35 U.S.C. §103

The test for obviousness under 35 U.S.C. 103 is whether the claimed invention would have been obvious to those skilled in the art in light of the knowledge made available by the reference or references. *In re Donovan*, 184 USPQ 414, 420, n. 3 (CCPA 1975). It requires consideration of the entirety of the disclosures of the references. *In re Rinehart*, 189 USPQ 143, 146 (CCPA 1976). All limitations of the Claims must be considered. *In re Boe*, 184 USPQ 38, 40 (CCPA 1974). In making a determination as to obviousness, the references must be read without benefit of applicant's teachings. *In re Meng*, 181 USPQ 94, 97 (CCPA 1974). In addition, the propriety of a Section 103 rejection is to be determined by whether the reference teachings appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed substitution, combination, or other modifications. *In re Lintner*, 173 USPQ 560, 562 (CCPA 1972).

A basic mandate inherent in Section 103 is that a piecemeal reconstruction of prior art patents shall not be the basis for a holding of obviousness. It is impermissible within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. *In re*

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

Kamm, 172 USPQ 298, 301-302 (CCPA 1972). Phrased somewhat differently, the fact that inventions of the references and of applicant may be directed to concepts for solving the same problem does not serve as a basis for arbitrarily choosing elements from references to attempt to fashion applicant's claimed invention. *In re Donovan*, 184 USPQ 414, 420 (CCPA 1975).

It is also clearly established in the case law that a change in the mode of operation of a device which renders that device inoperative for its stated utility as set forth in the cited reference renders the reference improper for use to support an obviousness-type rejection predicated on such a change. See, e.g. *Diamond International Corp. v. Walterhoefer*, 289 F.Supp. 550, 159 USPQ 452, 460-61 (D.Md. 1968); *Ex parte Weber*, 154 USPQ 491, 492 (Bd.App. 1967). In addition, any attempt to combine the teaching of one reference with that of another in such a manner as to render the invention of the first reference inoperative is not permissible. See, e.g., *Ex parte Hartmann*, 186 USPQ 366 (Bd.App. 1974); and *Ex parte Sternau*, 155 USPQ 733 (Bd.App. 1967).

In the case of *In re Wright*, 6 USPQ 2d 1959 (CAFC 1988), the CAFC decided that the Patent Office had improperly combined references which did not suggest the properties and results of the applicant's invention nor suggest the claimed combination as a solution to the problem which applicant's invention solved.

The CCPA reached this conclusion after an analysis of the prior case law, at p. 1961:

We repeat the mandate of 35 U.S.C. 103: it is the invention as a whole that must be considered in obviousness determinations. The invention as a whole embraces the structure, its properties, and the problem it solves. See, e.g., *Cable Electric Products, Inc. v. Genmark, Inc.*, 770 F.2d 1015, 1025, 226 USPQ 881, 886 (Fed. Cir. 1985) ("In evaluating obviousness, the hypothetical person of ordinary skill in the pertinent art is presumed to have the 'ability to select and utilize knowledge from other arts reasonably pertinent to [the] particular

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

problem' to which the invention is directed"), quoting *In re Antle*, 444 F.2d 1168, 1171-72, 170 USPQ 285, 287-88 (CCPA 1971); *In re Antonie*, 559 F.2d 618, 619, 195 USPQ 6, 8 (CCPA 1977) ("In delineating the invention as a whole, we look not only in the claim in question... but also to those properties of the subject matter which are inherent in the subject matter and are disclosed in the Specification") (emphasis in original).

The determination of whether a novel structure is or is not "obvious" requires cognizance of the properties of that structure and the problem which it solves, viewed in light of the teachings of the prior art. See, e.g., *In re Rinehart*, 531 F.2d 1048, 1054, 189 USPQ 143, 149 (CCPA 1976) (the particular problem facing the inventor must be considered in determining obviousness); see also *Lindemann Maschinenfabrik GmbH v. American Hoist and Derrick Co.*, 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984) (it is error to focus "solely on the product created, rather than on the obviousness or notoriousness of its creation") (quoting *General Motors Corp. v. U.S. Int'l Trade Comm'n*, 687 F.2d 476, 483, 215 USPQ 484, 489 (CCPA 1982), cert. denied, 459 U.S. 1105 (1983)).

Thus the question is whether what the inventor did would have been obvious to one of ordinary skill in the art attempting to solve the problem upon which the inventor was working. *Rinehart*, 531 F.2d at 1054, 189 USPQ at 149; see also *In re Benno*, 768 F.2d 1340, 1345, 226 USPQ 683, 687 (Fed. Cir. 1985) ("appellant's problem" and the prior art present different problems requiring different solutions").

A reference which teaches away from the applicant's invention may not properly be used in framing a 35 U.S.C. 103 rejection of applicant's claims. See *United States v. Adams*, 148 USPQ 429 (Sup. Ct. 1966).

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

III. Rejection of Claims 20 and 28 under 35 U.S.C. §102(b)

Claims 20 and 28 stand rejected under 35 U.S.C. §102(b) as being anticipated by Goldstein (U.S. 2,701,679). Reexamination and reconsideration of the Examiner's rejection are requested.

As noted previously, claim 28 has been canceled herein and replaced by new dependent claim 104. As also note previously, the subject matter of prior dependent claim 27 has been removed from independent claim 20 herein and reinstated as new dependent claim 103. Accordingly, applicant responds below to the Examiner's rejection with respect to claim 20, as amended herein, and with respect to new claims 103 and 104.

Applicant's claim 20, as amended herein, recites the following:

Process for making a dispensing assembly comprising:

(a) providing carton means having a dispensing opening in a side wall thereof, pour spout means mounted in said dispensing opening and including a front panel and separate liner means in said carton;

(b) bonding said liner means to said front panel whereby upon initial opening of the pour spout means, that portion of the liner bonded to said front panel separates from said liner means providing access to the interior thereof.

The Examiner takes the position that Goldstein anticipates claim 20 and states the following in support of this position on page 2 of the Office action:

Goldstein discloses process for making dispensing assembly comprising providing carton means having a dispensing opening (Fig 2) in a side wall (11) thereof pour spout means (C) mounted in the dispensing opening and including a front panel (Fig. 4; via portion 23) and separate liner means in the carton (Figs. 3 and 4; via the upper

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

portion of ply A); bonding the liner means to the front panel (Fig. 9) whereby upon initial opening of the pour spout means that portion of liner bonded to the front panel separates from the liner means providing access to the interior thereof (Fig. 3)

The Examiner, thus, apparently takes the position that applicant's recited liner means is met by the "upper portion" of the Goldstein ply A. Applicant respectfully disagrees with this position for the reasons set forth below.

With reference to Figs. 6 and 7 of Goldstein, a carton blank is disclosed having extended ply areas "A" and "B". When the blank is formed into a carton, the ply areas overlap one another to form a two-ply construction in a portion of the carton (see Fig. 5). Specifically, the wall 11 and a portion of the adjacent walls 13 and 14 will be of two-ply construction. Goldstein discusses this, for example, as follows:

One upright side wall of the container, for example 11, and a small portion of the connecting walls 13 and 14 at right angles thereto are of two plies, namely, A and B.

(col. 1, lines 78-81)

Accordingly, the Goldstein inner ply A extends over only a relatively small portion of the carton; it cannot reasonably be considered to be a "liner" as recited in applicant's claim.

The Examiner further apparently takes the position that applicant's recitation of "bonding said liner means to said front panel" is met by Goldstein. Specifically, the Examiner suggests that the Goldstein inner ply A is attached to the panel 23. At the outset as noted above, the Goldstein ply A cannot reasonably be considered to be a "liner" as recited in claim 103. It is further pointed out, however, that in Goldstein, nothing (let alone a liner) is bonded to the panel 23.

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

With reference, for example, to Figs. 6 and 7, which show the blank from which the Goldstein carton is formed, the pouring spout C (e.g., Fig. 5) is formed from the ply A. A corresponding opening or hole is formed in the ply B. Although this opening is not numbered in the drawings, it is discussed by Goldstein, for example, as follows:

The outer ply of the wall 11 is incised to form a rectangular opening partially overlapped by a tab 18 attached at the upper end to the outer ply B by a score line 19.

(col. 2, lines 4-7)

When the blank is formed into a carton, the pouring spout C aligns with the opening in the ply B. Fig. 4 shows the carton after the pouring spout C has initially been opened and then re-closed. To open the carton, the pouring spout C is pulled through the opening in the ply B. This is discussed in Goldstein, for example, as follows:

... the lower section is adhesively fixed to the outer ply B below said rectangular opening and the upper section above the score line 24 is positioned opposite to the opening, so as to be pulled through the outer ply opening when desired.

(col. 2, lines 18-22)

Accordingly, the panel 23 is adjacent the opening in the outer ply B and nothing is bonded to the panel.

Since all of the limitations of applicant's claim 20 are not met by Goldstein, claim 20 is not anticipated by Goldstein. As noted above, to anticipate a claim for a patent, a single prior source must contain all its essential elements. *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 231 USPQ

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

81, 90 (Fed. Cir. 1986).

Claims 103 and 104 are allowable at least as depending from allowable
base claim 20.

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

**IV. Rejection of claims 21, 22, 95, 96, 101 and 102 Under 35 U.S.C.
§103(a)**

Claims 21, 22, 95, 96, 101 and 102 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goldstein (2,701,679). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 21 and 22 are allowable at least as depending from allowable base claim 20. Claims 21 and 22 are allowable on further independent grounds for at least the reasons set forth below.

The Examiner states the following on page 4 of the Office action:

Goldstein does not disclose that the pour spout means front panel comprises a lamination of a paperboard material and a plastic material. However, it would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified Goldstein's process for making a dispensing assembly by having a polyester material laminated to a paperboard material, as a matter of engineering design choice, since the examiner takes an official notice that the mentioned lamination of a paperboard material and a plastic polyester material is old, well known, and available in the art in order to avoid damaging the cardboard containers when filling them with a liquid, for example cardboard milk containers or juice containers.

The Examiner, thus, admits that neither Goldstein nor any of the other references of record provide any teaching, whatsoever, of applicant's use of a lamination as recited in claims 21 and 22. Applicant's use of a such a lamination is not a matter within the knowledge of a person of ordinary skill in the art and the Examiner has submitted no evidence to the contrary.

Accordingly, there is absolutely nothing in the file history of this prosecution to support the Examiner's statement. There must be something in the teachings of cited references to suggest to an individual skilled in the art that a claimed invention would be obvious. *W. L. Gore and Associates v. Garlock, Inc.*, 220

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

USPQ 303, 311 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). "There must be a reason or suggestion in the art for selecting the procedure used, other than the knowledge learned from the applicant's disclosure." *In re Dow Chemical Co.*, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988).

If the Examiner considers himself to be an expert in the field whose unsupported statements are to be given weight, then applicant respectfully requests that the Examiner set forth his qualifications in a sworn affidavit with appropriate supporting evidence.

Applicant further hereby traverses the Examiner's assertion of official notice. Applicant asserts that it is clearly not common knowledge to use a lamination of paperboard material and plastic material (and, specifically a polyester plastic material as recited in claim 22) in the front panel of a pour spout as recited. Applicant hereby demands that the Examiner produce authority for his statement in the form of documentary evidence if the present rejection is to be maintained. See MPEP §2144.04 C. If, as asserted by the Examiner, the use of a lamination, as recited, is "old, well known, and available in the art", then the Examiner should find no difficulty in producing a reference supporting this position.

Claims 95, 96, 101 and 102 have been canceled.

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

V. Rejection of claims 23-26 and 97-100 Under 35 U.S.C. §103(a)

Claims 23-26 and 97-100 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Goldstein (U.S. 2,701,679) in view of Knauf (U.S. 5,415,910). Reexamination and reconsideration of the Examiner's rejection are requested.

Claims 23-26 are allowable at least as ultimately depending from allowable base claim 20. Claims 23-26 are allowable on further independent grounds for at least the reason discussed below.

The Examiner's rejection is improper because there is no motivation to combine the references as proposed by the Examiner. To establish a *prima facie* case of obviousness based on a combination of the content of various references, there must be some teaching, suggestion or motivation in the prior art to make the combination. "It is insufficient to establish obviousness that the separate elements of the invention existed in the prior art, absent some teaching or suggestion, in the prior art, to combine the elements." *Arkie Lures, Inc. v. Gene Larew Tackle, Inc.*, 43 USPQ2d 1294, 1297 (Fed. Cir. 1997). Also, see *In re Raynes*, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993); *In re Oetiker*, 24 USPQ2d 1443, 1445 (Fed. Cir. 1992).

In the present case, there is no teaching, suggestion or motivation in either Goldstein or Knauf to combine the references as proposed by the Examiner. The only possible motivation to combine the references arises from the teachings in applicant's own application. Reliance upon applicant's own teachings in this manner, however, is not permissible since obviousness cannot be established by hindsight combination to produce the claimed invention. *In re Gorman*, 933 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991). As discussed in *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985), it is the prior art itself, and not the applicant's achievement, that must establish the obviousness of the

S.N. 10/027,744
Art Unit 3721
Atty Dkt PP 5.71(c)

combination.

Claims 97-100 have been canceled.

In view of the above, all of the claims are now believed to be in
condition for allowance. Re-examination and reconsideration are requested.

Respectfully submitted,

KLAAS, LAW, O'MEARA & MALKIN, P.C.

By 

Michael A. Goodwin, Reg. No. 32,697
KLAAS, LAW, O'MEARA & MALKIN, P.C.
1999 Broadway, Suite 2225
Denver, CO 80202
Telephone: (303) 298-9888
Fax: (303) 297-2266
Date: March 11, 2004